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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,806	08/04/2003	YuanQiao Rao	85018LMB	7231
7590	01/28/2005		EXAMINER	
Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			SCHILLING, RICHARD L	
			ART UNIT	PAPER NUMBER
			1752	
			DATE MAILED: 01/28/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/633,806	RAO ET AL.	
Examiner	Art Unit		
Richard L Schilling	1752		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 10 December 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5,7-11,13,14 and 16-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5,7-11,13,14 and 16-23 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_ .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_ .

1. Claims 1-3, 5, 9-11, 13, 14 and 16-23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Majumdar et al. '696 for the same reasons as set forth in paragraph 5 of the first Office action filed August 24, 2004. The aspect ratios of the clay particles in Majumdar et al. are preferably greater than 100 and the lengths of the particles are preferably .1-1 microns.

Applicants' argument that Majumdar et al. do not disclose hydrophilic organic splayant is unconvincing since Majumdar et al. (column 5, lines 37-53; column 6, lines 11-40) disclose organic ionic hydrophilic intercalating agents, e.g. alkyl ammonia compounds, organic surfactants.

2. Claims 1-3, 5, 7-11, 13, 14 and 16-23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dontula et al. '973 for the same reasons as set forth in paragraph 6 of the first Office action. Applicants' argument that Dontula et al. do not disclose hydrophilic splayant is unconvincing. Dontula et al. (see particularly column 7, line 65 - column 8, line 20) discloses that the clay particles are splayed with hydrophilic blocks of a polymer. Therefore, the clay particles are splayed with hydrophilic organic splayant. The entire block copolymers of Dontula et al. at least have some hydrophilic properties. Copolymers with polyether and polyamide blocks are disclosed as set forth in instant claim 8.

3. Claims 1-5, 7-11, 13, 14 and 16-23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Rao et al. for the same reasons as set forth in paragraph 7 of the first Office action. The Declaration under 37 CFR 1.131 is not of record in the instant application. However, the exhibit attachments have been received. If the Declaration has been submitted and lost by the Patent Office, any inconvenience caused applicants is regretted.

4. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent.

*In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-11, 13, 14 and 16-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,667,148 to Rao et al. Although the conflicting claims are

not identical, they are not patentably distinct from each other because the claimed elements in the U.S. patent comprise protective overcoats with clay particles splayed by hydrophilic polymers encompassed by the clay particles set forth in the instant claims. The working Examples in Rao et al. use the same clay particles as used in the working examples in applicants' specification. The instant claims and the claims in the U.S. patent cover imaging elements with the specific clay particles used in their respective working Examples.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty

in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7-9, 11, 13, 14 and 16-23 are rejected under 35 U.S.C. 102(a) and (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Majumdar et al. '656. Majumdar et al. '656 (see particularly paragraphs 10-12, 32, 65, 74-79, 82, 98) disclose imaging elements with layers comprising clay intercalated with polyether block polyamide copolymers as set forth in instant claim 8. The clay particles have lengths of .01-1 microns and aspect ratios preferably greater than 100. If Majumdar et al. '656 do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the clays of Majumdar et al. in imaging supports and layers coated thereon and to vary coverages according to desired purposes.

6. Claims 1-3, 5, 7, 9, 11, 14 and 16-23 are rejected under 35 U.S.C. 102(a) and (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dontula et al. '226 or Dontula et al. '815. Dontula et al. '815 is the published application corresponding to Dontula et al. '226. Dontula et al. '226 (see particularly column 7, line 22 - column 8, line 4; column 5, lines 3-66) and Dontula et al. '815 disclose imaging elements with supports containing clay particles intercalated with alcohol compounds having hydrophilic properties. The aspect ratios are preferably greater than 100 and the lengths are preferably .01-1 micron for the clay particles. If Dontula et.al.'815 do not anticipate the instant claims, the it would be at least obvious to use the clays in imaging supports and layers coated thereon and to vary coverages according to desired purposes in Dontula et al. '815.

7. Claims 1-3, 5, 7, 9, 11, 14 and 16-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,841,226 to Dontula et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the U.S. patent claims imaging members containing a layer with clay particles intercalated with alcohol compounds having hydrophilic properties. The clay particles of the claims

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of the U.S. patent include the specifically disclosed clay particles in the specification of the U.S. patent having aspect ratios and lengths as required by the instant claims.

8. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

January 26, 2005

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1100 1752

